

Application No.: 09/743,746  
Attorney Docket No.: 068800-0276611

### REMARKS

#### I. Status of the claims

Claims 1-6, 10, 11, 13-31, and 35-39 are pending. Claims 3, 14-19, 23-30, and 35-39 remain withdrawn. Applicants have amended claims 1, 10, and 11. Support for the claim amendments may be found in the specification on page 12, lines 1-3, example 3 and in original claim 12.

#### II. Rejection under 35 U.S.C. § 102(b)

The examiner has maintained the rejection of claims 1, 2, 4-6, 8, 11-12, 20, and 31 under 35 U.S.C. § 102(b) as being anticipated by the article authored by Nothnagel ("Nothnagel"). Applicants respectfully traverse this rejection.

In this response, Applicants have amended claim 1 to remove the --S-- group from the list of possible R' groups. Nothnagel, however, only describes a compound where R' is a thioester (--S--) group. Therefore, Nothnagel fails to teach Applicants' claimed invention.

Additionally, Nothnagel does not disclose a method for identifying an analyte, as recited in claim 1 of Applicants' claimed invention. Nothnagel only discloses a method for producing a probe for *labeling* cell plasma membranes that does not involve identification of an analyte.

Nothnagel does not disclose the specific step of cleaving the reporter group from the analyte where the compound is cleaved into two parts at a particular point, as recited in Applicants' claimed invention. The fragmentation that is observed in the mass spec characterization of the lipid/fluorophores complex that Nothnagel describes is incidental to the disclosure; the intention of Nothnagel was not to use the mass spectrometer to analyze one portion as a mass marker to identify the other portion. Therefore, one of ordinary skill in the art would not be motivated by the description of Nothnagel to reach the methods claimed by Applicants. Applicants' claimed invention recites a specific cleavage that is reproducible with other markers. The cleavage that takes place in the molecule disclosed in Nothnagel is neither specific nor reproducible. Further, there is no suggestion that it would be useful to use such a cleavage as a method of identifying an analyte, and Nothnagel does not disclose the identification of an analyte by identification of a reporter group.

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As amended, claim 1 and its dependent claims are novel over Nothnagel. Accordingly, Applicants respectfully request that the examiner withdraw this rejection under 35 U.S.C. § 102(b).

### III. Rejection under 35 U.S.C. § 112, second paragraph

The examiner has rejected claims 1, 2, 4-6, 8, 10-12, 20-22, and 31 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter.

In part A of the rejection, the examiner discusses the term "electron withdrawing" recited in claims 8 and 11. Applicants have cancelled claim 8 and removed the objected-to phrase from claim 11. Accordingly, Applicants respectfully request that the rejection in part A be withdrawn.

In part B of the rejection, the examiner discusses the term "wherein the cleavage takes place by beta-elimination between the R' group and the adjacent carbon atom" recited in step (b) of claim 1. Applicants have amended claim 1 to clarify that the cleavage takes place between the R' group and the carbon atom in the beta position with respect to the sulphone or sulfoxide. The reaction is exemplified in Figure 1 of the specification, which has been reproduced below:

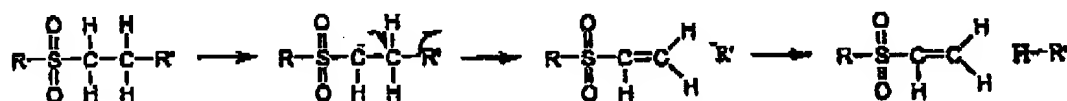


Figure 1

This amendment makes clearer to one of skill in the art where the cleavage reaction occurs. Because the scope of amended claim 1 is clear and distinctly claims the recited subject matter, Applicants respectfully request that the examiner withdraw the rejection to part B.

In view of the above remarks, Applicants respectfully request that the examiner withdraw this rejection under 35 U.S.C. § 112, second paragraph.

### IV. Double Patenting

The examiner has rejected claims 1, 2, 4-6, 8, 10-12, 20-22, and 31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent Nos. 6,582,916 and 6,287,780.

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Applicants have filed terminal disclaimers over both cited patents to obviate this rejection. Accordingly, Applicants respectfully request that the examiner withdraw this rejection.

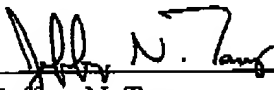
V. Conclusion

If any issues in the prosecution of this application remain unresolved, the examiner is encouraged to contact the undersigned counsel at the number listed below in order to resolve such issues.

Please charge any fees associated with the submission of this paper to Deposit Account No. 033975. The Director is also authorized to credit any overpayments to the above-referenced Deposit Account.

Respectfully submitted,

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